

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Steven Peter Colliver <i>et al.</i>)	Confirmation No. 9553
)	
Patent No. 7,501,556)	Group Art Unit: 1638
)	
Application No. 10/505,145)	Examiner: R. Kallis
)	
Filed: April 8, 2005)	
)	
For: Nutritionally Enhanced Plants)	

STATEMENT UNDER 37 C.F.R. 1.705(b)

This statement is respectfully submitted in support of the Petition For Patent Term Adjustment Under 37 C.F.R. § 1.705(d) for the above-referenced patent. In view of the following, it is respectfully requested that Patentees be granted a final patent term adjustment of 633 days and not 392 as indicated calculated by the Patent Office.

The Patent Term Adjustment (“PTA”) under 35 U.S.C. § 154(b) listed on the above-referenced patent is 392 days (a copy of the face of the patent is submitted herewith). This determination is in error in that pursuant to 35 U.S.C. § 154(b), the Patent Office failed to take certain action within the time frame specified in 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a) and failed to issue a patent within three years of the actual filing date of the above-referenced application in accordance with 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b).

The District Court for the District of Columbia issued a recent decision on PTA in the case of *Wyeth v. Dudas*, 580 F.Supp.2d 138 (D.D.C. 2008). In that case, the court ruled that patent applicants are entitled to term adjustments for Patent Office delay both under the provision that a patent shall issue within three years of the filing date as well as in instances of further Patent Office delay, such as in issuing an Office Action, so long as both did not occur on the same calendar day. *Id.* at 142.

Pursuant to 35 U.S.C. § 154(b)(1)(A), Patentees are entitled to a period of PTA for failure of the Patent Office to comply with statutory deadlines. Under 35 U.S.C. § 154(b)(1)(A)(i), the Patent Office should have issued a first Office Action by July 8, 2006 (within fourteen months of filing the application). This application was filed on April 8, 2005, and the Patent Office mailed a first Office Action on July 5, 2007, 392 days beyond the fourteen month statutory deadline. Accordingly, as the Patent Office has concluded (see attached PTA calculation), Patentees are entitled to a total period of Examination delay of 392 days under 37 C.F.R. § 1.702(b).

However, in addition to the PTA due to delay in commencing examination, pursuant to 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.703(b), Patentees respectfully submit that they are also entitled to a period of PTA due to the failure of the Patent Office to issue a patent within three years of filing the application (April 8, 2008). Under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.703(a), this additional period of PTA commenced April 9, 2008, and ended March 10, 2009, when the patent issued, 335 days beyond the three year guarantee.

Patentees submit that the two periods for PTA are not overlapping. The PTA under 35 U.S.C. § 154(b)(1)(A) of 392 days for the Patent Office's failure to issue an Office Action within fourteen months of filing the application occurred between April 8, 2005 and July 5, 2007. The PTA of 335 days for the Patent Office's failure to issue the patent within three years of filing under 35 U.S.C. § 154(b)(1)(B) occurred between April 9, 2008 and March 10, 2009.

Patentees further submit that the final PTA should reflect Patentees's own delay. The Patent Office issued a final Office Action mailed on April 11, 2008. Patentees filed an amendment after the final Office Action on July 11, 2008 under 37 C.F.R. § 1.116. Patentees had a shortened statutory period of three months to file a response. Accordingly, the response filed on July 11, 2008, was timely. However, Patentees received an Advisory Action from the Patent Office indicating the amendment would not be entered. Patentees filed a further amendment under 37 C.F.R. § 1.116 and a Notice of Appeal, along with a Request for Extension of Time for three months on October 14, 2008. The period of delay between when the statutory period of three months expired and when Patentees filed the Notice of Appeal was 94 days.

As set forth in 37 C.F.R. § 1.703(f), Patentees are entitled to a period of PTA equal to the period of delays based on the grounds set forth in 35 U.S.C. § 154(b) and 37 C.F.R. § 1.702, reduced by the period of time equal to the period of time during which Patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 C.F.R. § 1.704. Accordingly, Patentees submit that the Patent Office caused additional delay of 335 days in having the patent issue within three years of filing the application, lessened by Patentees's delay of 94 days in filing a response to the final Office Action mailed April 11, 2008. Patentees submit, therefore that the correct PTA for the above-referenced patent is 633 days.

In view of the foregoing, it is respectfully requested that this Petition for Patent Term Adjustment Under 37 C.F.R. § 1.705(d) be favorably considered and that a corrected determination of Patent Term Adjustment be issued to reflect a PTA of 633 days.

Dated: **May 8, 2009**
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Respectfully submitted
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